

II. REMARKS

Entry of the amendments is respectfully requested. Claims 5, 11, 15 - 18, 22, 23, and 33 have been cancelled. Claims 1 -4, 6-10, 12-14, 19-21, 24-32, 34-40 and also new claims 41-48 are now pending in the application. Favorable consideration and allowance of this application is respectfully requested in light of the remarks that follow.

1. Election of Species

Initially, Applicants wish to confirm the election of the invention of Figs. 11 and 12 covered by claims 1 -4, 6-10, 12-14, 19-21, 24-32, 34-40 as stated in the Office Action.. With this response, Applicants affirm this election by requesting that the claims previously withdrawn to the non-elected invention, namely, claims 5, 11, 15 - 18, 22, 23, and 33 be **cancelled** without prejudice from the application.

2. Rejections Based on the Prior Art

A. Recapitulation of the Invention

The present invention (i.e., a transporting accessory for a vehicle and method of loading and unloading the same) in its most basic form contemplates four (4) distinct members:

- 1) a base frame having two support members;
- 2) a second frame having two extension members, each extension member slidably borne by a respective one of the support members, each extension member having at least one guide and being movable along a path of travel between a first, retracted position and a second, extended position;
- 3) a carriage pivotally mounted to the second frame, the carriage having at least one arm, the at least one arm having at least one guide; and

- 4) a transport support having at least one track, the at least one track slidably borne by the at least one guide of the carriage, the transport support being movable along a path of travel between a first, retracted position and a second, extended position.

B. The Rejection

Claims 1 -4, 6-10, 12-14, 19-21, 24-32, 34-40 stand rejected in the current Office Action under 35 U.S.C. 103(a) as being unpatentable over either Dixon et al (USP 6,099,232) or Egan et al (USP 6,176, 672) in view of Masse (USP 5, 807,058).

It well-established that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 must be are applied to establish a background for determining obviousness under 35 U.S.C. 103(a). These are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining *the differences* between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering *objective evidence* present in the application indicating obviousness or nonobviousness.

The Office Action states that “either Dixon et al or Egan et al discloses a substantially similar transport accessory” **but** goes on to admit however that “Dixon et al or Egan et al does not disclose the specific drive arrangement.” The Action then claims “Masse discloses the specific drive arrangement” and thus “it would have been obvious to a mechanic with ordinary skill in the art at the time the invention was made to provide either primary reference with the specific drive arrangement” with the motivation being

“the known use of equivalents.”

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must *teach or suggest all the claim limitations*. (Emphasis added). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Furthermore, in *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed.Cir.2002), the Federal Circuit held that the Board's reliance on "common knowledge and common sense" of equivalents did not fulfill the agency's obligation to cite references to support its conclusions.

Claim 1

In reviewing the Graham test recited above, it is clear that fatal shortcuts were taken on steps 1 and 2. In reviewing the Claim 1 and the other claims at issue, it is not good enough to state that “substantially similar” transport accessories are disclosed in Dixon et al. or Egan et al. In fact, Egan et al. discloses a lift having only two of the required four parts claimed in the present invention, a support frame 14 and a ramp assembly 16. Egan et al., ‘672 Patent, Col. 2, lines 52-58. There is no disclosed 1)

second frame for extending beyond the box of the bed and likewise no 2) carriage assembly pivotably connected to the second frame as in the claimed invention. On the other hand, Dixon et al. discloses a lift having only three of the required four parts claimed in the present invention, a ramp 110, an interchangeable carriage 112 and a stationary frame 114 attached to the bed of a truck. Dixon et al., '232 Patent, Col. 7, lines 23-26. Again there is no disclosed second frame for extending the carriage that is pivotably connected thereto as in the claimed invention. Thus, Dixon and Egan clearly lack more than a drive arrangement as suggested. Further, Masse discloses a truck deck that is mounted onto the top of a pick up's flat bed. See Masse, '058 Patent, Col. 1, lines 1-42 and Figs. 1-10. In light of these facts, the Office must clearly set forth the reasons why there would some reason to combine these references, show a reasonable expectation of success, and show all of the limitations are present. As Applicants submit that the Office Action fails to establish a *prima facie* case of obviousness, claim 1 must be allowed.

Claim 2

Claim 2 adds the additional limitation of a drive assembly operable to move the extension members (of the second frame) between the first retracted position and the second extended position. As stated above although not all of the elements of the invention of Claim 1 are present in Dixon and Egan as alleged, it is further revealing to more completely review what is actually disclosed in Masse with regards to the drive. Again, the Action alleges the "drive arrangement" of the claimed invention is present in Masse. However, Masse merely discloses a truck deck having a support frame 12, guide tracks 14, guide members 16, a load platform 18, drive chains 20, and a winch mechanism 24. Masse, '058 Patent, Col. 4, lines 14-17. Guide members 16 fit into guide tracks 14. The guide members 16 are made up of a first portion 36 hinged to a second portion 38. Masse, Col. 4, lines 30-44. Moreover, in Masse the chains 20 and winch 24

are used to drive load platform 18 and not to drive the guide members 16. However in the present invention, the drive assembly is operably coupled to the extension members to move them. Clearly, there is no teaching to rearrange the primary references or Masse in any manner to get the invention of Claim 2. See also MPEP §2143.01. As there is no prima facie showing that claim 2 is obvious, thus claim 2 is allowable.

Claim 3

Claim 3 claims an actuator coupled to the second frame and the carriage to **pivot** the carriage. The Examiner has not indicated where such an actuator exists in Masse. Rather as Masse indicates, “pivotal movement occurs when the majority of the weight of the platform 18 passes the pivot axis which is pivot pin 40. “ Again, there is no prima facie showing that claim 3 is obvious, and thus claim 3 is allowable.

Claim 4

Claim 4 claims an electric actuator. The Action does not cite to any such actuator in the cited prior art and thus Claim 4 should be allowed.

Claim 6

In addition to having the elements in claim 1, claim 6 also claims the actuator and drive discussed above. Thus, claim 6 is allowable for at least the reasons discussed above.

Claim 7

Claim 7 claims an electric actuator as does claim 7. Again as the Action does not cite to any such actuator in the cited prior art, claim 7 should be allowed.

Claim 8

One way claim 8 is different claim 1 is that it claims a roller instead of a generic guide. Moreover, again as all of the limitations of claim 8 are not set forth in the prior art as cited, claim 8 should also be allowed.

Claim 9

In claim 9, the method of operating the device of invention is claimed. The claim specifically claims “activating a drive to move the extension members” and then claims “activating an actuators to pivot a carriage.” For at least the reasons discussed above, the cited prior art is lacking in this regard. Thus, claim 9 should be allowed.

Claim 29

One way claim 29 is different claim 1 is that it claims a drive operable to facilitate the movement of the transport assembly. Further as all of the limitations of claim 29 are not set forth in the prior art as cited, claim 29 should also be allowed.

Claim 36

Claim 36 claims subject matter that the Office has not show is disclosed or taught by the cited prior art. Thus, the method of operating the device of invention as claimed in claim 36 should be allowed.

Other Claims

Claims 10, 12-14 and claims 19-21, 24-28, 30-35, 37-40 and new claims 41-48 depend directly or indirectly from independent allowable claims 1,6, 8, 9, 29, and 36 and are believed to be in condition for allowance for incorporating by reference the limitations of those claims and for defining additional features of the invention, which,



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when considered in combination with those of the base claims, are neither taught nor suggested by the prior art relied upon in the rejection.

III. Conclusion

It is submitted that claims are in compliance with 35 U.S.C. §103 and each define patentable subject matter. Therefore, the Applicants respectfully request a Notice of Allowance be issued on these claims.

Should the Examiner have any questions or comments the attending to of which would expedite the prosecution of this application, the Examiner is invited to contact the undersigned at the telephone number appearing below.

No fees are believed to be payable with this communication. Nevertheless, should the Examiner consider any fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

Respectfully submitted,

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Dated: 3/22/04

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